



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,161	09/10/2001	Tsunetoshi Honma	067242-0152	9225

22428 7590 02/10/2005

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,161

Applicant(s)

HONMA ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 14 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 14 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 8, 14 and 19 are pending in the application.

This action is in response to applicant's amendment filed November 22, 2004.

Claim 8 was amended and claims 11-13 and 20-22 were canceled.

Response to Amendment

Applicant's arguments filed November 22, 2004 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the obviousness –type double patenting rejection of claims 8, 11-14 and 19-22 labeled paragraph 2) of the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the obviousness –type double patenting rejection of claim 19 labeled paragraph 2) of the last office action, which is hereby **withdrawn**.
3. With regards to the provisional obviousness-type double patenting rejection as being unpatentable over copending Application No. 10/297,065 of the last office action, the applicant's remarks have been fully considered but they are not persuasive. The applicant's stated that when the only rejection remaining is a provisional double patenting rejection, the Examiner should withdraw the rejection and allow the application to issue as a patent. However, this is not the only issue remaining.

Claims 8, 14 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3

Art Unit: 1624

and 8-22 of copending Application No. 10/297,065, for reasons of record and stated above.

4. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claims 8, 11-14 and 19-22 as being obvious over WO 97/00853 labeled paragraph 5) of the last office action, which is hereby **withdrawn**.

5. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 113, second paragraph rejections of claims 8, 11-14 and 19-22 labeled paragraph 6) of the last office action, which are hereby **withdrawn**.

In view of the amendment dated November 22, 2004, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 8, 14 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (I-94), which is missing an open parenthesis.

- b) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (I-129), which is missing a close "}".
- c) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (I-129), which is missing an open parenthesis.
- d) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (I-170), where the 7-Furan-3-ylmethyl.benzo[b]thiophene contains a period after the methyl.
- e) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (I-182), which is missing a close "}".
- f) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (I-182), which is missing an open parenthesis.
- g) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (II-15), which is missing a close "}".
- h) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (II-15), which is missing an open parenthesis.

- i) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (II-18), which is missing a close "}".
- j) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (II-18), which is missing an open parenthesis.
- k) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (II-21), which is missing a close parenthesis.
- l) Claim 8 and claims dependent thereon are vague and indefinite in that it is not known what is meant by the nomenclature of the species labeled (II-21), which is missing an open bracket.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 1624

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with the first name "Brenda" and last name "Coleman" clearly distinguishable.

Brenda L. Coleman
Primary Examiner Art Unit 1624
February 9, 2005